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EXAMINER

MCALLISTER, STEVEN B

ART UNIT PAPER NUMBER

3627

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/917,338

Applicant(s)

NISHI ET AL.

Examiner

Steven B. McAllister

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. The examples below are not intended to be exhaustive.

Claim 1 recites "said step" but provides no antecedent basis.

Claim 1 is unclear because it is not clear grammatically to what "for storing a calculation" refers.

Claims 3 is unclear because it recites "at least one operating button" and later "said operating button". The later recitation should be consistent with the first.

Claim 4 is indefinite because "the information" lacks antecedent basis.

Claim 5 recites "dusk" in line 3.

Additionally, claims 6-11 provide for the use of an accounting system, but, since the claim does not positively set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite

where it merely recites a use without any active, positive steps delimiting how this use is actually practiced. It is noted that claim 6 recites "an accounting fee calculation step for" but no step is ever positively recited; rather intended use of the step comprising the "for calculating an accounting fee..." is provided.

Claim 11 is indefinite because it recites that the electronic appliance is video RAM and/or a network interface. The specification appears to show that the apparatus comprises these features, not that it is one. Additionally, and/or further makes the claim indefinite.

Claim 12 is indefinite because "belonged" is unclear.

Claim 13 is indefinite because "status of a user from said " is unclear.

Claim 15 is indefinite because it is not clear to what "manager" refers in lines 6-8.

Claim 16 is indefinite because it is not clear what the "function manager" is.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-5 and 17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The recited method of claims 1-5 and 17 lack a technological nexus (e.g., positively claiming that the steps are accomplished via an electronic computer.)

No rejection was made regarding claims 6-11 since no positive method step was recited, but were the claims to be amended to positively recite method steps, a technological nexus would be required for those claims.

Claims 6-11 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 5-8, 10-14 and 17-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Reeder (5,832,812).

Reeder shows accessing a formula and calculating an accounting fee comprising user charges for online services.

As to claim 2, Reeder shows all elements.

As to claim 5 and 10, Reeder shows at least period of use.

As to claim 6-8, Reeder shows all elements.

As to claim 11, Reeder shows a network interface.

As to claim 12, Reeder shows a service offering unit; function managing unit; an accounting processing unit capable of selecting an appropriate accounting method according to the respective service offering functions.

As to claim 13 Reeder further shows a usage information collecting unit; wherein the accounting system selects the accounting method according the user usage status data which is collected.

As to claim 14, Reeder further shows a usage information collecting unit; wherein the accounting system selects an accounting method according to the the user usage status data which is collected.

As to claims 17-19, Reeder shows offering services to the user; managing service offering functions of the appliance, and selecting an appropriate accounting method according to the service offering and performing the processing.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 5, 9-11, and 15 rejected under 35 U.S.C. 103(a) as being unpatentable over Reeder.

As to claims 3, 5, 9-11, Reeder shows charging a fee when the at least one button (which for example downloads a file) is pushed. It does not explicitly show a remote control device. However, it is notoriously old and well known in the art to control a personal computer via remote control device comprising a keyboard. It would have been obvious to one of ordinary skill in the arts to modify the method of Reeder by providing a keyboard in order to provide a well known way to interact with the computer.

As to claim 15, Reeder shows that the electronic appliance uses user data to identify itself to the online system; that the accounting system performs the account processing by using computer setting status data (e.g., setting status showing that it is set to be connected or disconnected) such that it receives status data and user identification data; that it associates the identification data with manager identification data, selecting a processing method according the manager identification data. It does not show that the user information is stored managed by an electronic appliance number data managing unit. However, it is notoriously old and well known in the art to for user data to be stored and managed on the computer and passed to an online system during an automated sign-on. It would have been obvious to one of ordinary skill in the art to modify the system of Reeder by managing the user information by a data number managing unit in order to avoid having to sign on manually.

Claims 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Block (5,960,416).

Block shows a service offering unit for offering service to a user; a function managing unit for managing a service offering; and an accounting processing unit. Block does not show that the service offering unit provides a plurality of services. However, it is notoriously old and well known in the art for a unit to provide a plurality of services (such as cell phone service, web browsing, emailing, instant messaging, etc.) with a single unit. It would have been obvious to one of ordinary skill in the art to modify the apparatus of Block by providing a plurality of services in order to give added functionality to the customer and provide extra selling points.

It is noted that Block shows all elements of claims 13 and 14.

As to claim 15, Block further shows that the unit is provided with a number data managing unit since the system contemplates monitoring the use of a cell phone and cell phones have such a number managing unit; a manager identification data managing unit; and that the accounting system receives appliance number data and setting status information, associates the appliance number with manager identification data, and selecting the accounting method accordingly.

As to claim 16, Block further shows that the appliance has a function identification data managing unit since the unit provides a plurality of functions; that the accounting system has a function manager data managing unit; and that the accounting system processes by receiving function identification information and function embedded data comprising the unit that the function is embedded in, the accounting



system associating the function identification data with the function manager identification data to select the processing method.

Claims 1, 2, 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Google Groups printout in view of Griffin (5,893,077).

Google shows a system in which calculates an accounting fee based on a calculation formula for use of the appliance (the appliance comprising a web server). It does not explicitly show that the calculation formula is stored and retrieved in the calculation. However, Griffin shows these steps. It would have been obvious to one of ordinary skill in the art to modify the method of Google in order to provide for automated electronic calculation of monthly charges.

As to claims 2, all elements are shown.

As to claim 4, Google shows that the appliance has an accumulating medium and charging for its use.

As to claim 5, Google shows at least period of use (per month).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. McAllister whose telephone number is (703) 308-7052. The examiner can normally be reached on M-Th 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert P. Olszewski can be reached on (703) 308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Steven B. McAllister